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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,108	09/29/2003	Thomas R. Goecke	5923.0001	2438

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Brennan, Manna & Diamond, LLC
The Carnegie Building
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Akron, OH 44308

EXAMINER

NORDMEYER, PATRICIA L

ART UNIT	PAPER NUMBER
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1783

NOTIFICATION DATE	DELIVERY MODE
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08/23/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/674,108	Applicant(s) GOECKE, THOMAS R.	
	Examiner Patricia L. Nordmeyer	Art Unit 1783	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 15 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Reopening of Prosecution

In view of the remand filed on May 6, 2010, PROSECUTION IS HEREBY REOPENED.

Upon further reconsideration of the applied prior art and arguments of record, all rejections of record as set forth in the Non-final rejection dated October 19, 2006 are hereby withdrawn. As new prior art has been found and claims furthered analyzed, new rejections have been applied below.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 – 7, 9 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 contains the limitation of “substantially uniform,” which is not supported by the specification. The specification is silent with regard to the thickness being uniform. However, the specification does state that the polymer layer contains a textured surface. It is unclear how the polymer layer contains both a substantially uniform thickness and a textured surface.

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Claims 2 – 7, 9 and 10 are also rejected under 35 U.S.C. 112 1st paragraph due to their dependency on the above rejected claim.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 – 7, 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "substantially uniform" in claim 1 is unclear, which renders the claim vague and indefinite. Claim 1 states that the thickness of the polymer layer is substantially uniform; while claim 3 states that the polymer layer has a textured surface. How can the polymer layer have a uniform thickness while having a textured surface?

Claims 2 – 7, 9 and 10 are also rejected under 35 U.S.C. 112 2nd paragraph due to their dependency on the above rejected claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by DeRusha et al. (USPN 4,484,574).

DeRusha et al. discloses an adhesive tape (Abstract) comprising: a polymer layer having a thickness between 0.031” and 0.236” (Column 2, lines 14 – 23), the polymer layer defining a first side (Figure 1, #16); and a double sided adhesive layer where one side of the double sided adhesive layer¹ is in substantially continuous contact with the first side of the polymer layer (Figure 1, #12) and an opposing side of the double sided adhesive layer is disposed to adhere to the flooring environment (Column 3, lines 28 – 52; Figure 1, #12, wherein the adhesive can attach to any substrate surface, Column 5, lines 1 - 5); where the adhesive tape has a peel adhesion of 250 g/cm to 850 g/cm width, which meets the limitation of a peel adhesion greater than 2.0 lb/in width (2.0 lb/in width converts to 357 g/cm width) (Column 3, lines 41 – 52) as in claim 12.

As to the limitation of “adhesive layer is disposed to adhere to the flooring environment”, the term disposed, as defined by Merriam-Webster’s, means “to give a tendency to”. Since the adhesive tape of DeRusha et al. meets the claim limitations, it would be capable of, or disposed to, adhere to a flooring environment.

¹ The Examiner notes that any layer of adhesive has two sides, each side having adhesive properties. Therefore, the reference’s disclosure of a layer of adhesive anticipates the claim limitation of a double sided adhesive layer.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 – 3, 5, 7 and 9 – 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnston et al. (USPN 3,895,153).

Independent claims 1 and 11 will be addressed first.

As to claim 1, Johnston et al. discloses an adhesive article that can be formed into any shape, (Abstract; Column 8, lines 16 - 20) comprising a polymer layer having a Shore A Hardness of between about 60 and 95 (Figure 4, #18; Column 4, lines 51 – 55) and a substantially uniform thickness of 10 to 60 mils or 0.010" to 0.060" (Figure 4, #18; Column 5, lines 48 – 52); and a layer of adhesive attached to said polymer layer (Figure 6, #38).

As to claim 11, Johnston et al. also disclose an adhesive tape that can be cut into any shape including a narrow strip or band, (Abstract; Column 8, lines 16 - 20) comprising: a polymer layer having a Shore A Hardness of between about 60 and 95 (Column 4, lines 51 – 55); and a layer of pressure sensitive adhesive comprising a first side and an opposed second side (Figure 6, #38), the first side being in direct and uninterrupted contact with the polymer layer (Figure 6, #38) where the adhesive tape comprises an average thickness between 13.5 and 78 mils, since the backing sheet has a thickness of 1 to 5 mils (Column 4, lines 29 – 31) in combination with the primer layer having a thickness of 0.5 to 3 mils (Column 4, lines 45 – 47),

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the copolymer layer having a thickness of 10 to 60 mils (Column 5, lines 48 – 52) and the adhesive layer having a thickness of 2 to 10 mils (Column 6, lines 11 – 13).

Johnston et al. differs from claims 1 and 11 in two ways. First, Johnston et al. fails to disclose an anticipatory example, or ranges that are sufficiently specific to anticipate the ranges of Shore A Hardness (claims 1 and 11), polymer layer thickness (claim 1) or overall tape thickness (claim 11). However, Johnson et al. teaches a range of Shore A Hardness of between about 60 and 95 (Column 4, lines 51-55) which overlaps the claim 1 and 11 range of between about 92 and 100. Johnston et al. teaches a polymer layer thickness of 0.010 to 0.060" which overlaps the claim 1 range of between about 0.020 and 0.065". Lastly, Johnston et al. teaches an overall thickness of 13.5 to 78 mils which overlaps the claim 11 range of between about 65 and 69 mils. Overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

Therefore, it would have been obvious to one of ordinary skill in the art to have selected from the overlapping portion of the ranges of Shore A Hardness and thickness taught by Johnston et al. because overlapping ranges have been held to establish *prima facie* obviousness.

Second, Johnson et al. fail to specifically refer to its article as being an "adhesive tape." Johnston et al. teaches that the article can be formed into any shape, (Abstract; Column 8, lines 16 - 20). The term "tape," as defined by Merriam-Webster's, means "a narrow flexible strip or band." And, It is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. In the instant case, the application does not indicate any new,

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significant attributes of the invention due to its shape which would have been unforeseen to one of ordinary skill in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape to change the shape of the adhesive article to be in the form of a narrow strip or band. One skilled in the art would have been motivated to do so in order to change the appearance of the adhesive article. MPEP 2144.04 IV.

With regard to claim 2, the article contains a substrate attached to an outermost side of said layer of adhesive (Figure 6, # 39).

For claim 3, the polymer layer includes a textured surface (Figure 4, #18).

Regarding claim 5, the polymer layer includes coloring pigment (Column 5, lines 38 – 48).

As in claim 7, the adhesive comprises a rubberized double-sided tape (Column 3, lines 43 – 49, since the adhesive has adhesive qualities on the opposite sides of the layer, it reads upon a double side adhesive product).

With regard to claim 9, polymer layer has a Shore A Hardness of between about 60 and 95, thereby meeting the limitation of a Shore A Hardness of 93 and 97 (Column 4, lines 51 – 55).

For claim 10, the adhesive is pressure sensitive (Column 5, lines 67 – 69).

9. Claims 1 – 6, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reeves et al. (USPN 5,508,084).

Reeves et al. discloses a repositionable article that can be cut into any shape, (Column 7, lines 34 – 36) comprising a polymer layer (Figure 2d, #19; Column 10, lines 21 – 29) having a

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Shore A Hardness of between about 70 and 140 (Column 14, lines 25 – 29) and a substantially uniform thickness of between about 0.020" to 0.065" (Column 10, lines 30 – 35) and a layer of adhesive attached to said polymer layer (Figure 2d, #13; Column 12, lines 30 – 44).

Reeves et al. differs from claim 1 in two ways. First, Reeves et al. fails to disclose an anticipatory example, or ranges that are sufficiently specific to anticipate the claim 1 range of Shore A Hardness. However, Johnson et al. teaches a range of Shore A Hardness of between about 70 and 140 (Column 14, lines 25 – 29) which overlaps the claim 1 range. Overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

Therefore, it would have been obvious to one of ordinary skill in the art to have selected from the overlapping portion of the ranges of Shore A Hardness taught by Reeves et al. because overlapping ranges have been held to establish *prima facie* obviousness.

Second, Reeves et al. fails to specifically refer to its article as being an “adhesive tape.” Reeves et al. teaches that the article can be formed into any shape, (Column 7, lines 34 – 36). The term “tape,” as defined by Merriam-Webster’s, means “a narrow flexible strip or band.” It is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape which would have been unforeseen to one of ordinary skill in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape to change the shape of the adhesive article to be in the form of a

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narrow strip or band. One skilled in the art would have been motivated to do so in order to change the appearance of the adhesive article. MPEP 2144.04 IV.

With regard to claim 2, the article contains a substrate attached to an outermost side of said layer of adhesive (Column 13, lines 10 – 15).

For claim 3, the polymer layer includes a textured surface (Figure 2d; Column 12, lines 16 - 23).

With regard to claim 4, the polymer layer is comprised of a polyvinyl chloride (Column 13, lines 28 – 36).

Regarding claim 5, the polymer layer includes coloring pigment (Column 12, lines 25 – 31).

As in claim 6, the polyvinyl chloride comprises a clear polymer (Column 12, lines 25 – 31).

With regard to claim 9, polymer layer has a Shore A Hardness of between about 70 and 140, which overlaps the limitation of a Shore A Hardness of 93 and 97 (Column 14, lines 25 – 29).

For claim 10, the adhesive is pressure sensitive (Column 8, lines 9 – 13). However, Reeves et al. fail to disclose that the adhesive article is specifically an adhesive tape.

10. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hornibrook et al. (USPN 4,248,762).

Hornibrook et al. disclose a pressure sensitive product (Column 1, lines 10 – 13) comprising: a polymer layer having a thickness between 0.002” and 0.020”, thereby overlapping

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the thickness limitation of 0.020" and 0.065" (Column 2, lines 1 – 15), the polymer layer defining a first side (Figure 1, #1); and a double sided adhesive layer where one side of the double sided adhesive layer is in substantially continuous contact with the first side of the polymer layer (Column 2, lines 16 – 39; Figure 2, #2) and an opposing side of the double sided adhesive layer is disposed to adhere to the flooring environment (Column 2, lines 16 – 39; Figure 2, #2); where the adhesive tape has a peel adhesion of 7.5 pounds per linear inch, which meets the limitations of a peel adhesion greater than 2.0 lb/in width (Column 5, lines 1 – 3) as in claim 12.

Hornibrook et al. differs from claim 12 in two ways. First, Hornibrook et al. fails to disclose an anticipatory example, or ranges that are sufficiently specific to anticipate the claim 12 range of thickness of 0.020 to 0.065". However, Hornibrook et al. teaches a range of thickness of 0.002" and 0.020" (Column 2, lines 1 – 15), which overlaps the claim 12 range of between 0.020 and 0.065". Overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

Therefore, it would have been obvious to one of ordinary skill in the art to have selected from the overlapping portion of the ranges of Shore A Hardness taught by Reeves et al. because overlapping ranges have been held to establish *prima facie* obviousness.

Second, Hornibrook et al. fail to disclose that the adhesive article is specifically an adhesive tape.

The term tape, as defined by Merriam-Webster's, means "a narrow flexible strip or band". It is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen

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improvements to the invention. In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape which would have been unforeseen to one of ordinary skill in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape of the adhesive article to be in the form of a narrow strip or band. One skilled in the art would have been motivated to do so in order to change the appearance of the adhesive article. MPEP 2144.04 IV.

As to the limitation of “adhesive layer is disposed to adhere to the flooring environment”, the term disposed, as defined by Merriam-Webster’s, means “to give a tendency to”. Since the adhesive product of Hornibrook et al. meets the claim limitations, it would be capable of, or disposed to, adhere to a flooring environment.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571)272-1496. The examiner can normally be reached on Mon.-Fri. from 10:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, David R. Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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